



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,533	01/26/2001	Madoka Mitsuoka	1405.1033/JDH	4908

21171 7590 12/08/2005

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

ROSEN, NICHOLAS D

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/769,533

Applicant(s)

MITSUOKA ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner. *& accepted by Draftsperson*
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/26/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-10 have been examined.

#### ***Claim Objections***

Claim 2 is objected to because of the following informalities: Claim 2 recites "said prompting," which now lacks antecedent basis, as claim 1 has been amended to remove the reference to a prompting step, by that name. Appropriate correction is required.

Claim 9 is objected to because of the following informalities: The claim still fails to set forth method steps as active steps. E.g., "the received delivery request is stored" should be either "storing the received delivery request", or "wherein the received delivery request is stored", and similarly throughout the claim. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1, 5, 6, and 7**

Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of official notice. As per claim 1, Tartal discloses a method for managing delivery of products that have been ordered, including: accepting applications for delivery of said products from a provider of said products (Abstract; paragraphs 10 and 25); assigning application ID's to said applications (paragraphs 10, 25, and 35); notifying a delivery recipient of the products, and accepting delivery terms (paragraphs 25, 30-32, and 35); and accepting designation of delivery terms for the application(s) specified by said application ID's from said delivery recipient after orders of said products (paragraphs 30-37). Tartal does not expressly disclose a presenting step of presenting said delivery recipient with a list of the products scheduled to be delivered to said delivery recipient and said application ID, although this can be considered as disclosed if a list with one item is still a list (paragraphs 21-26). However, the duplication of known parts is held to be obvious to one of ordinary skill in the art (*St. Regis Paper Co. vs. Bemis Co.*, 193 USPQ 8, 11; 549 F. 2<sup>nd</sup> 833 (7<sup>th</sup> Circuit 1977); *In re Harza*, 124 USPQ 378, 380; 274 F. 2<sup>nd</sup> 269, CCPA (1960)). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to present said delivery recipient a list of

products scheduled to be delivered, for the obvious advantage of making arrangements for delivery when more than one product was involved.

Similarly, Tartal discloses a requesting step of making a request for delivery by notifying a delivery business of the product corresponding to an application ID for which a delivery term has been requested, of the designated delivery term, and of the delivery recipient, but not doing this for a plurality of products for which the same delivery term has been designated (Abstract; paragraphs 10 and 30). Even reading an explicit limitation to a plurality of products into this clause, the duplication of known elements is held to be obvious, and official notice is taken that it is well known to deliver a plurality of products together. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to make a request for delivery of a plurality of products with the same delivery terms, for the obvious advantages of reducing the number of trips required of a delivery service, and the number of days when a recipient must wait at home to receive products.

Tartal does not disclose presenting screen for the steps of the recited method, but official notice is taken that it is well known to present a series of screens for displaying information and accepting data to be input. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to present a series of screens, for the obvious advantage of enabling information to be conveniently displayed and other information to be conveniently inputted.

As per claim 5, Tartal discloses a user judging step of judging whether said delivery recipient is the party that ordered said product(s) (paragraphs 23 and 24). Tartal does not disclose notifying the provider of said products that the products specified by said application ID's have been purchased after said term accepting step, according to a result of said judging, but official notice is taken that it is well known to notify product providers that products have been purchased. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to notify the provider as claimed, for the obvious advantage of arranging for the shipping and delivery of ordered products.

As per claim 6, Tartal discloses judging whether said delivery recipient is the party that ordered said product(s) (paragraphs 23 and 24); and accepting cancellations of orders (or at least deliveries) for said products specified by said application ID's (paragraphs 31 and 32); and notifying the provider of said products for which the order specified by said application has been cancelled, according to a result of said judging (paragraphs 31 and 32) (returning the products to the sender is held to constitute notification).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of official notice. Claim 7 is closely parallel to claim 1, and rejected on essentially the same grounds, except that claim 7 does not recite presenting screens, so official notice that it is well known to present screens is not requisite in regard to claim 7.

It is noted that claim 7 uses "means for" language. Nonetheless, it is not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

#### **Claims 8 and 9**

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of Piggins (U.S. Patent Application Publication 2002/0046153) and official notice. Tartal discloses a delivery information service method, including: receiving a delivery request for an article (Abstract; paragraph 21), and storing a received delivery request in a storage device (paragraphs 24-26). Tartal does not disclose searching a storage device for pending deliveries with the same delivery recipient as the delivery recipient of said delivery request, but Piggins teaches searching a customer profile for relevant items (paragraphs 6, 13, and 14). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to search the storage device for pending deliveries with the same delivery recipient, for the obvious advantage of arranging the delivery of desired products.

Tartal does not expressly disclose referring to an address table and extracting the notification address of the delivery recipient, but being able to make deliveries implies possessing addresses, and official notice is taken that it is well known to maintain files of people's addresses, and extract the addresses therefrom. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to refer to an address table and extract the notification address therefrom, for the obvious advantage of delivering the article or articles to the correct the address.

Tartal discloses that, based on desired delivery terms, instructions are made for delivery to the delivery recipient of the article scheduled for delivery, said instructions being given to a delivery business that has been designated by the desired conditions or that matches desired conditions (Abstract; paragraphs 26, 30, 37, and 38).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of Piggins (U.S. Patent Application Publication 2002/0046153) and official notice. Claim 8 recites, in essence, a computer program for carrying out the method of claim 9, and is therefore rejected on essentially the grounds set forth above with regard to claim 9.

#### **Claim 10**

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article "SmartShip.com Announces Multi-Carrier Shipping and Tracking Function for E-Commerce," hereinafter "SmartShip," in view of official notice.

"SmartShip" discloses a method for processing for delivery of an item, comprising:



Art Unit: 3625

accepting at a computer delivery terms of the item wherein said delivery terms are entered by a prospective recipient of the item after the prospective recipient is, at least, "ready to purchase items" (entire article, especially paragraph beginning "By linking three information elements"). "SmartShip" does not expressly disclose that the item has been ordered, although the language can be read as indicating that the item has been ordered, or at least selected to be ordered, but official notice is taken that it is well known to provide delivery information after an item has been ordered, or at least selected for ordering; hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the item to have been ordered, for the obvious advantage of arranging for the delivery of ordered items.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of official notice. Tartal discloses a method for processing for delivery of an item, comprising: accepting at a computer delivery terms of the item wherein said delivery terms are entered by a prospective recipient of the item (paragraphs 30-32, "via return e-mail" being taken as necessarily implying a computer of some type). Tartal does not expressly disclose that this is done after the item has been ordered, but official notice is taken that when an attempt is made to deliver an item to a customer, as in Tartal, it is very often because the customer has ordered the item. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to accept delivery terms after the item has been ordered, for the obvious advantage of arranging for delivery in the case of an ordered item, rather than one sent unsolicited.

***Allowable Subject Matter***

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further amended to overcome the objection set forth above.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Tartal et al. (U.S. Patent Application Publication 2004/0039712), discloses or makes obvious the limitations of claim 1, as set forth above. However, neither Tartal nor any other prior art of record discloses, teaches, or reasonably suggests a group accepting step of accepting formation of a group and designation of group members from said delivery recipients; and said prompting step further including a group notification step of giving notification of a list of products scheduled for delivery to other members of the group to which the delivery recipient belongs, and the application ID's therefor. It is known to accept formation of a group and notify the members of such a group (e.g., forming an e-mail list, and sending a post to all members of such a list), and it is known to leave a message and/or a package with a neighbor if the intended recipient of a package isn't available when the deliveryman comes by, but these do not suffice to teach the recited limitations.

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Tartal et al. (U.S. Patent Application Publication 2004/0039712), discloses or makes obvious the limitations of claim 1, as set forth above. Tartal does not expressly disclose that said application accepting step further includes a step of accepting an application for delivery of a first product of said products and an application for delivery of a second product of said products, with corresponding first and second delivery terms, but it is well known to order multiple products. However, Tartal does not disclose a judging step of judging whether prior to delivery of the first product, a second delivery term is designated for the second product; and a term changing step of changing the first delivery term set for the first product to the second delivery term set for the second product according to a result of the judging step (nor the slightly different limitations of claim 4). No other prior art of record discloses, teaches, or reasonably suggests these limitations. The closest prior art for these limitations is Kawasaki (Japanese Published Patent Application 11-272752 A), and Kawasaki, although related to the modification of delivery dates, does not teach the limitations recited in either claim. It would be surprising if no one had thought to deliver two products to the same recipient together, even if they might otherwise have been delivered at the same time, but doing so is not held to meet the detailed limitations of claims 3 or 4.

***Response to Arguments***

Applicant's arguments filed April 12, 2005 have been fully considered but they are not persuasive. Applicant argues that Tartal (U.S. Patent Application Publication 2004/0039712) does not qualify as prior art, because it was filed after Applicant's application (filed January 26, 2001, claiming foreign priority to July 31, 2000). However, while Tartal's application 10/311,742 was filed June 19, 2001, it claims priority to provisional applications 60/212,596, filed June 19, 2000, and 60/255,407, filed December 15, 2000. Provisional applications can be relied upon to establish priority in making rejections (see MPEP, 2127). Furthermore, Examiner has obtained these provisional applications, and also 60/220,289, the provisional application filed July 24, 2000, relied upon for Piggins (U.S. Patent Application Publication 2002/0046153), which Applicant did not expressly challenge, but which poses a similar issue of a patent publication filed after Applicant's priority date, but claiming priority to a provisional filed earlier. 60/220,289 closely resembles the Piggins publication, with the paragraphs relied upon appearing there word-for-word. 60/212,596 and 60/255,407 do not match the Tartal publication so directly, but do provide support for the invention set forth therein having been invented, and described in documents filed with the U.S. Patent Office, before the filing date of the instant application.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hilbush et al. (U.S. Patent Application Publication 2005/0038758) disclose Internet package shipping systems and methods. Duncan (U.S. Patent Application Publication 2005/0171862) discloses an on-line interactive system and method for transacting business.

The provisional applications 60/212,596, 60/212,596, and 60/255,407 are made of record, as set forth in the Response to Arguments section above, as providing evidence for the priority of the art relied upon.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762, or e-mailed to [Nicholas.Rosen@USPTO.gov](mailto:Nicholas.Rosen@USPTO.gov).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
NICHOLAS D. ROSEN  
PRIMARY EXAMINER  
December 5, 2005